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PTO/SB/21 (09-04)

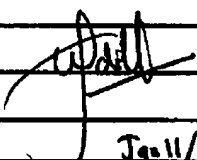
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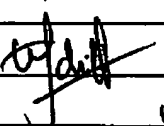
TRANSMITTAL FORM	Application Number	09/990,522
	Filing Date	November 21, 2001
	First Named Inventor	Choy-Pik Chiu, et al.
	Art Unit	1636
	Examiner Name	Quang Nguyen
	Attorney Docket Number	097/002
(to be used for all correspondence after initial filing)		
Total Number of Pages in This Submission	(5)	

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks Request to Withdraw Finality of Office Action Pursuant to 37 CFR 1.113(b), and MPEP 708.07(d) (3 pages) ***last page marker (1 page)***		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Geron Corporation		
Signature			
Printed name	J. Michael Schiff		
Date	Jan 11/05	Reg. No.	40,253

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Typed or printed name	MICHAEL SCHIFF	Date	Jan 11/05

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Name

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Choy-Pik Chiu & Robert Kay

Filing Date: November 21, 2001

Serial No: 09/990,522

Docket: 097/002

Title: TOLERIZING ALLOGRAFTS OF
PLURIPOTENT STEM CELLS

Art Unit: 1636

Examiner: Quang Nguyen, Ph.D.

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JAN 11 2005

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION
PURSUANT TO 37 CFR § 1.113(b), AND MPEP § 706.07(d)Commissioner for Patents and Trademarks
Washington, D.C. 20231

Dear Sir,

Applicant respectfully requests that the Examiner withdraw the finality of the Office Action dated January 30, 2003 (Paper No. 17).

This is not a Petition under 37 CFR § 1.181, or a Request for Continued Examination under 37 CFR § 1.114. Applicant requests that the finality be withdrawn pursuant to MPEP § 706.07(c) and (d), on the basis that the finality is premature.

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The Amendment filed on June 29, 2004 provided a full and complete response to the rejections made in the final Office Action dated March 29, 2004. Enclosed with the Amendment was a Declaration under 37 CFR § 1.132 by Dr. Anish Majumdar, providing data that illustrates that hPS derived mesenchymal cells have the desired properties to effect specific immune tolerance, in accordance with the claimed invention.

The only Office Action in which applicant's arguments and Dr. Majumdar's Declaration were considered is the Office Action mailed November 1, 2004 — the first Action after applicants filed the Request for Continued Examination (RCE) and paid the requisite fee. Nevertheless, the Action has been made a first-action final. It refers back to the Advisory Action of July 28, 2004 as the basis for rejecting the application. Although the Advisory Action opines on the June 29 Amendment, it does not constitute a full Office Action on the merits.

Applicant respectfully submits that in view of all the papers filed on June 29, it is inappropriate for the first action after the RCE to be made final.


If the current Office Action had not been made final, applicant would be able to consider and respond to the Examiner's arguments in full, and to put forward any type of claim amendments that might further prosecution. Applicant was unable to do so in response to the March 29 Office Action, because the Action was final, and extensive amendments could have been denied entry for raising new issues. Applicant filed the RCE in order to have an additional full round of prosecution, with the right to make whatever amendments could be helpful. Now that the first Office Action after the RCE has also been made final, applicant is again limited in the extent of the amendments it can make for fear that the response will not be entered into the file.

In effect, applicant is in the same position after filing the RCE as we would have been had we *not* filed the Amendment and the § 1.132 Declaration on June 29. Surely this is unfair, since applicant has made a genuine effort to advance prosecution since the Office Action of March 29.

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Accordingly, applicant respectfully requests that the finality of the most recent Office Action be withdrawn, pursuant to MPEP § 706.07(d).

Respectfully submitted,



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January 4, 2005

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Facsimile Transmittal Sheet

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Attorney Docket 097/002